

Remarks

Claims 1-19, 21-37 and 41-42 are pending in the application with claims 1, 21-24, 34-35 and 37 as independent. Claim 31 is cancelled and claims 41-42 are newly added.

Claims 1-4, 6-16, 18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weare et al. (US Patent 7,065,416, hereinafter Weare) in view of McEachern (US Patent 5,615,302, hereinafter McEachern).

Claims 24-29, 31-32 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laroche (US Patent 6,453,252, hereinafter Laroche) in view of McEachern.

Claims 5, 17, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weare in view of McEachern further in view of Official Notice.

Claims 30 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larouche in view of McEachern further in view of Official Notice.

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent

form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewriting to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Rejection Under 35 U.S.C. 103

Claims 1-4, 6-16, 18 and 21-23

Claims 1-4, 6-16 and 18 are listed in the preamble of the Examiner's arguments as rejected under 35 U.S.C. 103(a) over Weare in view of McEachern. However, Applicants respectfully note that specific grounds of rejection are actually provided for claims 1-4, 6-16, 18 and 21-23. The rejection of claims 1-4, 6-18, 18 and 21-23 is respectfully traversed.

First, although claim 1 includes similar recitations as those contained in claims 22-23 nevertheless the claims are different. For example, claim 1 recites "comparing selected segments to features of stored programs to identify thereby said media program; whereas claims 22-23 do not. Claims 22-23 recite means for limitations whereas claim 1 does not. However, in the Office Action the Examiner lumped claims 1 and 22-23 together and only addressed the limitations of claim 1; therefore the limitations of claims 22-23 that are different from claim 1 have not been addressed. The applicants respectfully note that when a claim utilizes "means for" recitations, the Examiner is required to consider the specific structure described in the specification to interpret these limitations. In lumping the claims, the Examiner failed to properly address the means for recitation of claims 22 and 23. A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all the claims in the group. See MPEP §707.07(d). A new non-Final Action distinctly addressing each and every claim limitation is respectfully requested.

Second, according to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicants's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Third, independent claim 1 is amended to recite: “determining whether said subsequent media program subset exhibits similarities to said initial media program subset,” which is neither taught nor fairly suggested by Weare et al. alone or in combination with McEachern. (emphasis added). McEachern fails to bridge the substantial gap between Weare and Applicants’ invention of at least amended independent claim 1.

In the Office Action, the Examiner cites Laroche at col. 5, lines 29-32 for the proposition that Laroche teaches the above limitation. (See Office Action, pages 9-10). Applicants respectfully disagree. The cited passage is reproduced here to facilitate comparison with the inventive recitation.

“In a preferred embodiment the invention is implemented in software, stored on a computer-readable storage structure, executed by a computing system which may include a digital signal processor (DSP). (See Laroche at col. 5, lines 29-32). As can be seen Laroche fails to disclose “determining whether said subsequent media program subset exhibits similarities to said initial media program subset.” Accordingly, withdrawal of the rejection is respectfully requested. The Office Action failed to establish a *prima facie* case of obviousness, because the combination of Weare and McEachern fails to teach or suggest all the claim limitations.

Finally, independent claims 21-23 are amended to recite: “storing at least 30 minutes worth of segments,” which is neither taught nor fairly suggested by Weare et al. alone or in combination with McEachern. (emphasis added). McEachern fails to bridge the substantial gap between Weare and Applicants’ invention of at least amended

independent claims 21-23. Therefore, the Office Action failed to establish a *prima facie* case of obviousness, because the combination of Weare and McEachern fails to teach or suggest all the claim limitations. Accordingly, withdrawal of the rejection is respectfully requested.

Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also patentable under 35 U.S.C. 103(a) over Weare in view of McEachern.

Therefore, Applicants' claims 1-4, 6-16, 18 and 21-23 are patentable under 35 U.S.C. 103(a) over Weare in view of McEachern. Applicants respectfully request the Examiner withdraw the rejection.

Claims 24-29, 31-32 and 34-37

Claims 24-29, 31-32 and 34-37 are rejected as being unpatentable under 35 U.S.C. 103(a) over Laroche in view of McEachern. The rejection is traversed.

Independent claims 24 and 34-35 are amended to recite: "determining whether said subsequent media program subset exhibits similarities to said initial media program subset," which is neither taught nor fairly suggested by Laroche alone or in combination with McEachern. (emphasis added). As articulated above, Laroche fails to disclose the above limitation. McEachern, on the other hand, fails to bridge the substantial gap between Laroche and Applicants' invention of at least amended independent claims 24 and 34-35.

Independent claim 37 is amended to recite: "storing at least 30 minutes worth of segments," which is neither taught nor fairly suggested by Laroche alone or in combination with McEachern. (emphasis added). McEachern fails to cure the deficiencies of Laroche. As such, the Office Action failed to establish a *prima facie* case of obviousness, because the combination of Laroche and McEachern fails to teach or suggest all the claims' limitations. Therefore, amended independent claims 24, 34, 35 and 37 are patentable under 35 U.S.C. 103(a) over Laroche in view of McEachern. Accordingly, withdrawal of the rejection is respectfully requested.

Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also patentable under 35 U.S.C. 103(a) over Laroche in view of McEachern.

Therefore, Applicants' claims 24-29, 31-32 and 34-37 are patentable under 35 U.S.C. 103(a) over Laroche in view of McEachern. Applicants respectfully request the Examiner withdraw the rejection.

Claims 5, 17, 19, 30 and 33

Claims 5, 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weare in view of McEachern. The rejection is traversed.

Claims 5, 17 and 19 are listed in the preamble of the Examiner's arguments as rejected under 35 U.S.C. 103(a) over Weare in view of McEachern. However, Applicants respectfully note that specific grounds of rejection are actually based on common knowledge in the art or Official Notice.

First, claims 5, 17 and 19 depend from independent claim 1. Since all of the dependent claims that depend from independent claim 1 include all the limitations of independent claim 1, each such dependent claim is also patentable under 35 U.S.C. 103(a) over Weare in view of McEachern. Accordingly, any attempted combination of the Weare and McEachern references with any other additional references, in a rejection against the dependent claims, would still result in a gap in the combined teachings in regards to the independent claims. Therefore, the rejection should be withdrawn.

Second, in rejecting claim 5, the Examiner acknowledges that Weare in view of McEachern does not specifically disclose wherein said plurality of filters includes at least a set of triangular filters. (See Office Action, paragraph 5, page 11). The Examiner went on to state that using triangular filters as a smoothing filter is well known in the art. The Examiner in essence took Official Notice of "using triangular filters as a smoothing filter." Applicants believe that the above limitation is not of notorious character and certainly not insubstantial as to "fill in the gaps." The Examiner is respectfully reminded that it is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the principal evidence upon which a rejection was

based. (See Ahlert, 424 F.2d at 1092, 165 USPQ 421 and MPEP §2144.03). The Examiner is therefore requested to produce authority for this and the other Official Notice taken with respect to claims 17, 19, 30 and 33.

Third, in rejecting claim 17, the Examiner failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or combine the reference teachings. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991) (MPEP 2144). In an attempt to articulate a motivation, the Examiner makes the following statement: "Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ Hamming window filter." (See Office Action page 12). The Examiner fails to explicate why an artisan of ordinary skill in the art would be motivated to perform said modifications. The Examiner's conclusory statement is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection. *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). Accordingly, the Examiner fails to meet the requirements set forth in MPEP §706.02(j).

Finally, Applicants submit that it is impermissible to use the claims as a framework from which to choose among individual references to recreate the claimed invention. *W. L. Gore Associates, Inc. v. Garlock, Inc.* 220 U.S.P.Q. 303, 312 (1983). Moreover, the mere fact that a prior art structure could be modified to produce the claimed invention would not have made the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783, Fed. Cir. (1992); *In re Gordon* 221 U.S.P.Q. 1125, 1127, Fed. Cir. (1984). This is a classical case where "obviousness is deceptive in hindsight." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

The prior art does not suggest such desirability. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art and then-accepted wisdom in the

field. W. L. Gore Associates, Inc. v. Garlock, Inc. 220 U.S.P.Q. 303, 312 (1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one “to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” Id. Applicants have thus shown that there are missing claimed features not taught or, suggested by the cited reference, and thus Claim 17 has been erroneously rejected under 35 U.S.C. §103(a). The Examiner failed to establish a prima facie showing of obviousness.

As for claims 19, 30 and 33, the same arguments articulated above equally apply to these claims.

As for claims 30 and 33, similar to claims 5, 17 and 19 above, the claims are listed in the preamble of the Examiner’s arguments as rejected under 35 U.S.C. 103(a) over Laroche in view of McEachern. Again, Applicants respectfully note that specific grounds of rejection are actually based on common knowledge in the art or Official Notice rather than obviousness.

Conclusion

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 530-9404 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

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